

REMARKS

Claims 169-187, 189-190, 192-201, 221-224, 234-248, 250-257, 268-272, 277-285, 301-305, 312-314, 317-319, and 322-329 are pending in the application. Reconsideration of the claims in view of the following remarks is respectfully requested.

I. Request For Interview

The Applicants respectfully request an interview with the Examiner after review of the following response. The undersigned attorney, John C. Gatz, may be reached at (312) 425-8515.

II. IDS Consideration

The Applicants filed a Fourth Information Disclosure Statement (IDS) on November 19, 2002, a Fifth IDS on January 23, 2003, and a Sixth IDS on February 18, 2003. The Applicants are concurrently filing herewith a Seventh IDS. The Applicants would respectfully request that the Examiner review the references in the Fourth, Fifth, Sixth and Seventh IDS', and make them of record.

III. Obviousness-Type Double Patenting Rejections

Claims 164-329 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of the following U.S. Patent Nos. 5,295,196; 5,430,664; 5,467,405; 5,790,697; 5,806,650; 5,815,592; 5,867,589; 5,870,487; 5,875,259; 5,905,810; 5,992,601; 6,012,565; 6,073,744; 6,220,419 B1; 6,237,739 B1; 6,241,069 B1; 6,278,795 B1 and 6,311,819 B1.

First, the Applicants note that only claims 169-187, 189-190, 192-201, 221-224, 234-248, 250-257, 268-272, 277-285, 301-305, 312-314, 317-319, and 322-329 are pending -- not claims 164-329. This also applies to all of the other rejections that will be discussed later in this response.

Second, as discussed in the previous two replies to Office Actions, to formulate an obviousness-type double patenting rejection, the claims of the pending application must be compared to the claims of an application or a patent. *See* MPEP 804. In the Office Action, none of the claims of the above-identified U.S. patents has been specifically identified as relating to the obviousness-type double patenting rejections. The Applicants has previously asked the

Examiner for either (a) an identification of the specific claim(s) of each of the above-identified U.S. patents or, alternatively, (b) for these obviousness-type double patenting rejections to be withdrawn, so as to adequately respond to the rejections. *See* previous Responses to the Office Actions filed on February 19, 2002 and August 23, 2003. The Applicants believe that all of the obviousness-type double patenting are improper, but since none of the claims of the above-identified U.S. patents has been specifically identified as relating to the obviousness-type double patenting rejections, the Applicants cannot properly respond to these rejections.

IV. Provisional Obviousness-Type Double Patenting Rejections

As previously discussed in the Responses to Office Actions filed on February 19, 2002 and August 23, 2003, to obviate some of the provisional obviousness-type double patenting rejections, the Applicants will file a terminal disclaimer with respect to Application Nos. 09/541,170, 09/542,487 and 09/607,019 when the other rejections have been withdrawn provided such terminal disclaimer remains necessary. With respect to the remaining provisional obviousness-type double patenting rejections, the Applicants respectfully request the withdrawal of such rejections because the claims of each of the applications have many elements that are not present in any of the claims of the present application. This is discussed in detail in the previous Responses to Office Actions in which the Examiner has not provided any comments thereto. Thus, the Applicants believe that the provisional obviousness-type double patenting rejections with respect to Application Nos. 09/684,103, 09/635,967 and 09/126,580 should be withdrawn.

As discussed in the previous Responses to Office Actions, the Applicants believe that Application No. 09/864,423 recited in the Office Action is not an application owned by the assignee of the present application. The Applicants note that Application No. 08/864,423 is an application owned by the assignee of the present application and issued as U.S. Patent No. 6,311,819, which was recited in the obviousness-type double patenting rejection. The Examiner has not provided any basis on why Application No. 09/864,423, which is not commonly owned by the Applicants, should be included a provisional obviousness-type double patenting.

V. 35 U.S.C § 103(a) Rejections

A. U.S. Patent No. 5,419,423 to Ishida

Ishida does not teach or suggest at least one feature of each and every claim of the present invention. For example, each of the independent claims recites, *inter alia*, (a) receiving a stack of bills in an input receptacle, (b) halting the transporting when a flagged bill from the stack of bills meets or fails to meet a non-piece criterion, and (c) counting the denomination of bills. The Examiner acknowledges that these features are not present in the Ishida by failing to cite passages in Ishida that support such features.

“[I]dentification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention.” *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000), (citing *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998)). “When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references.” *Rouffet*, 149 F.3d at 1355, 47 U.S.P.Q.2d at 1456, (citing *In re Geiger*, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987)). A *prima facie* case of obviousness can *only* be set up where there is “a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to combine them in the way they were combined by the inventor.” *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 U.S.P.Q.2d 1321, 1329 (Fed. Cir. 1998); *see also In re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1943-44 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988). Evidence of a suggestion, teaching, or motivation to combine “must be clear and particular.” *Ex parte Maruyama*, 2001 WL 1918556, *3 (Bd. Pat. App. & Inter. 2001), (citing *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998)).

To render the claimed invention obvious, the Examiner “must identify specifically . . . the reasons one of ordinary skill in the art would have been motivated to select the references and combine them.” *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999), *abrogated on other grounds by In re Gartside*, 203 F.3d 1305, 53 U.S.P.Q.2d 1769 (Fed. Cir. 2000), (quoting *In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q.2d 1453, 1459 (Fed. Cir. 1998)). Obviousness cannot “be established using hindsight or in view of the teachings or suggestions of the invention.” *Ex parte Maguire* (Appendix 9), 2002 WL 1801466, *3 (Bd. Pat.

App. & Inter. 2002), (quoting *Para-Ordnance Mfg. Inc. v. SGS Importers Int'l Inc.*, 73 F.3d 1085, 1087, 37 U.S.P.Q.2d 1237, 1239 (Fed. Cir. 1995), *cert. denied*, 519 U.S. 822 (1996)). In other words, the knowledge to combine “*can not* come from the applicant’s invention itself.” *In re Oetiker*, 977 F.2d 1443, 1447, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992) (emphasis added).

Section 103(a) mandates that the “invention must be considered as a whole” in obviousness determinations. *Rockwell Int'l Corp. v. U.S.*, 147 F.3d 1358, 1364, 47 U.S.P.Q.2d 1027, 1031 (Fed. Cir. 1998), citing *W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 1551, 220 U.S.P.Q. 303, 312-313 (Fed. Cir. 1983); see also *Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 1567, 220 U.S.P.Q. 97, 101 (Fed. Cir. 1983).

The Office Action stated the following: “[i]t is considered that receiving bills in the form of stacks is well known in the art as a form to present bills to a bill sorting apparatus.” In support of this statement, the Office Action apparently has relied upon Takesako (U.S. Patent No. 4,694,963), which discloses an apparatus for sorting sheets. This statement in the Office Action, however, is not applicable to Ishida because there is no teaching or suggestion in Ishida for an input receptacle that receives a stack of bills. In fact, Ishida teaches away from such an input receptacle in that a vending machine receives one bill at a time directly from the customer. Thus, there is no teaching or suggestion of including an input receptacle adapted to receive a stack of bills in the vending machine processor of Ishida.

Furthermore, it is improper to combine the paper money processor of Ishida adapted to be used in a vending machine with the apparatus for sorting sheets of Takesako. These references are fundamentally different and there is no motivation or suggestion to combine these references. The Ishida device does not halt the flagged bill from a stack of bills that meets or fails to meet a non-piece count related criterion. Ishida does not receive a stack of bills from the input receptacle of the device and, thus, cannot transport or halt bills from the stack of bills.

Additionally, there is no teaching or suggestion of counting bills in the 32-column disclosure of Ishida. The fact that Ishida determines whether bills are genuine or false does not teach or suggest the counting of the bills. The Examiner has provided no support for his statement “as this device [Ishida] is considered to be part of a vending machine, it is, at the very least, considered to be inherent that the device would interface with the vending machine, which could be expected to be able to determine the denomination of the bill” at page 13 of the Office Action. The Examiner has also provided no support for the statement “Ishida et al. is also

intended to be used in the environment of a vending machine, which inherently accounts for the bills detected” at page 13 of the Office Action. The Applicants respectfully request that the Examiner cite a reference in support of these statements. Otherwise, the Applicants cannot further evaluate these statements and respond accordingly.

Also, some of the independent claims (independent claims 221, 234, 239, 250, 255, 277, 284 and 285) have a feature directed to the speed of processing the bills of at least 800 bills per minute. There is no teaching or suggestion of having such a speed obtained in the device of Ishida used in vending machines. In fact, Ishida teaches away from such speeds by having customers place one bill at a time in the vending machines. The statement that “whatever the rate of bills counted per minute, the apparatus of Ishida et al nonetheless operates such that the method of Applicants’ is necessarily performed” at page 3 of the Office Action is contradictory to the Ishida disclosure.

Thus, independent claims 169, 178-180, 189, 190, 192, 221, 234, 239, 250, 255, 268, 277, 284, 285, 301, 312, 314, 317, 322, and 326 are not obvious over Ishida or the combination of Ishida and Takesako. Claims 170-177, 181-187, 193-201, 222-224, 235-238, 240-248, 251-254, 256, 257, 269-272, 278-283, 302-305, 313, 318, 319, 323-325, and 327-329, which depend either directly or indirectly on a respective one of the above-identified independent claims should be allowable over Ishida or the combination of Ishida and Takesako for at least the same reasons.

Takesako, does not disclose, *inter alia*, (a) halting the transporting such that a flagged bill is the last bill in one of the output receptacles, (b) wherein the flagging comprises halting the transporting when a bill meets or fails to meet at least one of the criteria, (c) wherein the flagging comprises halting the transporting when a bill is flagged because the denomination of the bills is not determined or is a suspect bill, (d) stopping a transport drive motor in response to the stopping signal as a result of a no call signal or a suspect signal, (e) halting the transporting in a predetermined manner in response to a determination that a bill meets a stranger bill criterion and in response to a determination that a bill meets a no call bill criterion, (f) presenting no call bills in a third one of the output receptacles, (g) presenting bills not having the target denomination in a third one of the output receptacles, and (h) upon encountering a bill having neither the first target denomination nor the second target denomination, then stopping the operation of the device if both the first and second output receptacles have one or more bills therein. One or more of such features are disclosed in each of the independent claims of the present application.

Rather, in Takesako, bills that are not recognized or that do not fit under preset criteria are referred to as “reject bills” and “are stacked in the reject stacker 22.” Col. 7, lines 57-58. In fact, the device in Takesako appears to be designed to halt only when a preset number of bills is reached in one of the output receptacles. *See, e.g.*, col. 2, lines 47-50 (“when bills corresponding in quantity to the stack capacity or to a specified quantity less than the stack capacity . . . the sorting operation is automatically interrupted”), and col. 10, lines 57-61 (“[t]he restart key 84 is operated for resuming the sorting operation on a lot of bills set in the feeder 12 after it has been interrupted in such a case as when the specified quantity is stacked in the stacker 18 or 20.”). Thus, claims 164-329 are not anticipated by or obvious over Takesako.

Thus, independent claims 169, 178-180, 189, 190, 192, 221, 234, 239, 250, 255, 268, 277, 284, 285, 301, 312, 314, 317, 322, and 326 are not obvious over Takesako. Claims 170-177, 181-187, 193-201, 222-224, 235-238, 240-248, 251-254, 256, 257, 269-272, 278-283, 302-305, 313, 318, 319, 323-325, and 327-329, which depend either directly or indirectly on a respective one of the above-identified independent claims should be allowable over Takesako for at least the same reasons.

C. U.S. Patent Nos. 5,201,395 to Takizawa and 5,301,786 to Yoshihara

Takizawa and Yoshihara also do not disclose, *inter alia*, (a) receiving a stack of bills in an input receptacle, and (b) halting the transporting when a flagged bill from the stack of bills meets or fails to meet a non-piece criterion. Such features are recited in all of the independent claims of the present application.

As discussed above, the Office Action stated the following: “[i]t is considered that receiving bills in the form of stacks is well known in the art as a form to present bills to a bill sorting apparatus.” This statement in the Office Action is irrelevant because there is no teaching or suggestion in either Takizawa or Yoshihara for an input receptacle that receives a stack of bills.

Takizawa is directed to “a bill examination device used in an automatic cash deposit/dispensation machine or an automatic vending machine”. Col. 1, lines 5-9 and col. 2, lines 23-28. The device of Takizawa does not have an input receptacle adapted to receive a stack of bills. *See, e.g.*, col. 1, lines 11-17 (“[w]hen a bill (i.e., bank note or paper currency) is inserted or entered by a customer into an automatic cash deposit/dispensation machine or an

automatic vending machine, the denomination of the bill is identified and the authenticity of the bill is tested.”).

Yoshihara is directed to “validating a paper-like piece such as a bill or bank note, a note used as a substitute for money, a gift card or a bill made of plastics....” Col. 1, lines 9-12 and col. 3, lines 64-68. The device of Yoshihara, as shown in, for example, FIG. 5, does not have an input receptacle adapted to receive a stack of bills, but rather appears to be used in a similar manner as Takizawa (*i.e.*, in a automatic cash deposit/dispensation machine or an automatic vending machine).

In fact, both Takizawa and Yoshihara teach away from such an input receptacle that receives a stack of bills. Takizawa and Yoshihara disclose an automatic cash deposit/dispensation machine or an automatic vending machine that receives one bill at a time directly from the customer. There is no teaching or suggestion of including an input receptacle adapted to receive a stack of bills in the automatic cash deposit/dispensation machine or an automatic vending machine vending machine processor of Takizawa or Yoshihara. The devices of Takizawa and Yoshihara do not halt the flagged bill from a stack of bills that meets or fails to meet a non-piece count related criterion. The devices of Takizawa and Yoshihara do not receive a stack of bills from the input receptacle of the device and, thus, cannot transport or halt bills from the stack of bills.

Furthermore, it is improper to combine the processor of Takizawa or Yoshihara that is adapted to be used in a cash deposit/dispensation machine or an automatic vending machine with the apparatus for sorting sheets of Takesako. Takizawa and Yoshihara are fundamentally different from Takesako and there is no motivation or suggestion to combine these references. For example, there is no teaching or suggestion that adding multiple output receptacles from Takesako would increase “work output and efficiency” in Takizawa as stated in the Office Action. In fact, such an addition of multiple outputs would increase the complexity of the transportation path. Such a reason does not provide motivation or suggestion to combine these references.

Also, some of the independent claims (independent claims 221, 234, 239, 250, 255, 277, 284, and 285) have a feature directed to the speed of processing the bills of at least 800 bills per minute. There is no teaching or suggestion of having such a speed obtained in the devices of Takizawa and Yoshihara used in a cash deposit/dispensation machine or an automatic vending

machine. In fact, Takizawa and Yoshihara teach away from such speeds by having customers place one bill at a time into their respective machines.

Thus, independent claims 169, 178-180, 189, 190, 192, 221, 234, 239, 250, 255, 268, 277, 284, 285, 301, 312, 314, 317, 322, and 326 are not obvious over Takizawa, Yoshihara or the combinations of Takizawa, Yoshihara, and Takesako. Claims 170-177, 181-187, 193-201, 222-224, 235-238, 240-248, 251-254, 256, 257, 269-272, 278-283, 302-305, 313, 318, 319, 323-325, and 327-329, which depend either directly or indirectly on a respective one of the above-identified independent claims should be allowable over Takizawa, Yoshihara, or the combinations of Takizawa, Yoshihara, and Takesako for at least the same reasons.

D. U.S. Patent No. 5,761,089 to McNerny

McNerny, does not disclose, *inter alia*, (a) two or more output receptacles, and (b) determining the denomination of the bills. Such features are recited in all of the independent claims of the present application.

McNerny discloses a counterfeit document detection apparatus that includes only one output receptacle. *See* FIGs. 1 and 2a, and col. 3, line 58-col. 4, line 3. The Office Action states that “receiving stacks of bills and feeding them to two or more output receptacles would be a matter of design choice, based upon the output or workflow required.” Applicants respectfully traverse the argument. McNerny contains no teaching or suggestion to use two or more output receptacles. Specifically, there is no motivation to modify the device of McNerny to use a more complicated and costlier transportation path for processing bills in the counterfeit document detection apparatus of McNerny. This clearly appears to be impermissible hindsight. Obviousness cannot “be established using hindsight or in view of the teachings or suggestions of the invention.” *Ex parte Maguire* (Appendix 9), 2002 WL 1801466, *3 (Bd. Pat. App. & Inter. 2002), (*quoting Para-Ordnance Mfg. Inc. v. SGS Importers Int’l Inc.*, 73 F.3d 1085, 1087, 37 U.S.P.Q.2d 1237, 1239 (Fed. Cir. 1995), *cert. denied*, 519 U.S. 822 (1996)).

The Examiner has provided no support for the statement that “determination of the denomination of bills, it would be expected that an apparatus that counts and batches bills (see col. 3, lines 58 and 59) would necessarily have to determine the denomination of the bills in order to function.” Neither the term “count” nor the term “batch” relates to denominating bills. Additionally, as previously mentioned, pursuant to MPEP § 2144.03, the Applicants respectfully

request that the Examiner cite a reference in support of the above statement. Otherwise, the Applicants cannot further evaluate this statement and respond accordingly.

The apparatus of McNerny does not denominate bills, but rather is a document counting and handling device that can count, verify and stack a particular type of document, such as currency of the same denomination. *See generally* col. 1, lines 18-20; col. 2, lines 3-7 and 34-40; col. 3, lines 58-63 and col. 11, line 65 to col. 12, line 43. There is no teaching or suggestion of denominating bills in McNerny. In fact, McNerny discloses the opposite in that the user enters the denomination of the particular bill that is being counted in the batch (“[t]he DENOM SELECT key is used during step 226 of the control procedure to cycle through a list or menu to select that the denomination of bills to be counted in a particular run or to specify a piece count without regard to denomination”). Col. 18, lines 12-16 of McNerny.

Furthermore, McNerny does not disclose that “halting is performed such that the flagged bill is positioned as the last bill in the one of the output receptacles” as is recited in some of the independent claims (claims 169, 178-180, 189, 190 and 192). Rather, McNerny discloses that “[s]ince the document transport mechanism cannot be instantaneously stopped, both the counterfeit suspect and the next document in the input stack, if any, are delivered to the stacker as the motor is halted in step 290. The control procedure then passes to step 291 in which normal operation is resumed by removal of the counterfeit suspect and the next document from the stacker, placing the next document back into the hopper, and pressing the CONT key.” Col. 21, lines 49-56.

The Office Action also states “[s]uch detection characteristics [optical and magnetic characteristics] are inherently able to yield denomination of particular bills as the U.S. Treasury, for example, provides a particular magnetic strip for a specific type of denomination within each bill”, but provides no support for the same. McNerny does not teach or suggest or suggest that optical and magnetic characteristics are used to denominate bills, but rather discloses that the user enter the denomination of the bill being counted in the batch. Additionally, as previously mentioned, pursuant to MPEP § 2144.03, the Applicants respectfully request that the Examiner cite a reference in support of the above statement. Otherwise, the Applicants cannot further evaluate this statement and respond accordingly.

Thus, independent claims 169, 178-180, 189, 190, 192, 221, 234, 239, 250, 255, 268, 277, 284, 285, 301, 312, 314, 317, 322, and 326 are not obvious over McNerny. Claims 170-

177, 181-187, 193-201, 222-224, 235-238, 240-248, 251-254, 256, 257, 269-272, 278-283, 302-305, 313, 318, 319, 323-325, and 327-329, which depend either directly or indirectly on a respective one of the above-identified independent claims should be allowable over McNerny for at least the same reasons.

E. U.S. Patent No. 3,759,382 to Walkley

Walkley, does not disclose, *inter alia*, many features that are being presently claimed in the pending independent claims of the present application. For example, Walkley does not teach or suggest (a) “wherein the halting is performed such that the flagged bill is positioned as the last bill in one of the output receptacles” that is recited in independent claims 169, 178-180, 189, 190 and 192, (b) counting and denominating U.S. bills at a rate of at least 800 bills per minute, flagging suspect bills, and directing “stranger bills and no call bills to a first set of one or more of the output receptacles and directing suspect bills to a second set of one or more of the output receptacles, the output receptacles of the second set being different from the output receptacles of the first set” as recited in independent claim 221, (c) counting and denominating at a rate of at least 800 bills per minute, and halting the transporting when a no call bill is determined as recited in independent claims 234, 250 and 255, (d) counting and denominating at a rate of at least 800 bills per minute and halting the transporting when a suspect bill is determined as recited in independent claims 239, 250, and 255, (e) “halting the transport mechanism when a bill is determined to be suspect” or “stopping a transport drive motor in response to a stopping signal” in response to the suspect signal as recited in independent claims 268 and 301, (f) counting and denominating at a rate of at least 800 bills per minute and flagging bills that meet or fail to meet any of certain non-piece criteria wherein the flagged bill that meets or fails to meet at least a given set of the criteria positioned in one of the output receptacles as recited in independent claims 277 and 285, (g) flagging bills that meet or fail to meet any of certain non-piece criteria wherein the flagged bill that meets or fails to meet at least a given set of the criteria positioned in one of the output receptacles, including no calls bills, as recited in independent claims 277, 312, 314, and 317, and (h) various features related to routing and presenting bills in three output receptacles as recited in independent claims 284, 322, and 326. Walkley does not teach or suggest such features that are being recited in the independent claims of the present invention.

Thus, independent claims 169, 178-180, 189, 190, 192, 221, 234, 239, 250, 255, 268, 277, 284, 285, 301, 312, 314, 317, 322, and 326 are not obvious over Walkley. Claims 170-177, 181-187, 193-201, 222-224, 235-238, 240-248, 251-254, 256, 257, 269-272, 278-283, 302-305, 313, 318, 319, 323-325, and 327-329, which depend either directly or indirectly on a respective one of the above-identified independent claims should be allowable over Walkley for at least the same reasons.

The Examiner has made many generalized statements in the Office Action, of which many are not supported by any passage in the applied references and further go against the teaching of the applied references. The Applicants have specifically addressed some, but not all, of these generalized statements in this response. Some of these unsupported statements are in fact erroneous. *See*, for example the statement that "determining whether the bills meet or fail to meet a non-piece count related criterion (note that genuineness of a bill is construed to be a non-piece count related criterion as it does not relate to the denomination or the order of the bills)" at page 8 is erroneous in that a non-piece count related criterion could be related to denomination such as a stranger bill. The fact that the Applicants have not addressed all of the unsupported, generalized statements in the Office Action does not imply that these statements are correct or apply in the context as written.

CONCLUSION

The Applicants submit that the claims are in a condition for allowance and action toward that end is earnestly solicited. Applicants have enclosed herewith a clean version of the pending claims after entry of this Amendment. In addition, Applicants have enclosed herewith a check in the amount of \$420.00 for additional claims. The Commissioner is hereby authorized to charge deposit Account No. 10-0447 (47171-00269USC1) for any fees inadvertently omitted which may be necessary now or during the pendency of this application, except for the issue fee.

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Respectfully submitted,

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